REMARKS / ARGUMENTS

I. General Remarks

Please consider the application in view of the following remarks. Applicants thank the Examiner for his careful consideration of this application.

II. Disposition of Claims

Claims 1-4, 7-11, 14-18, 21, 22, 27, and 30 are pending in this application. Claims 5, 6, 12, 13, 19, 20, 28, and 29 were cancelled in previous responses.

Claims 1, 2, 7-9, 14-16, 21, 22, 27, and 30 stand rejected under 35 U.S.C. § 102(e). Claims 3, 4, 10, 11, 17, and 18 stand rejected under 35 U.S.C. § 103(a).

III. Rejections of Claims Under 35 U.S.C. § 102(e)

Claims 1, 2, 7-9, 14-16, 21, 22, 27, and 30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2005/0028976 by Philip D. Nguyen ("the Nguyen Application"). With respect to these rejections, the Final Office Action states:

> Claims 1-2, 7-9, 14-16, 21-22, 27, and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Nguyen, U.S. Patent Application Publication No. 2005/0028976 for the reasons cited previously.
>
> The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by and appropriate showing under 37 CFR 1.131.

(Final Office Action at page 2.) In response to Applicants' previous response and the Declaration Pursuant to 37 C.F.R. § 1.131 ("Declaration") submitted therewith, the Final Office Action states:

> Applicant has furnished for the Examiner's consideration the data connected with an experiment carried out in the United States prior to the effective filing date of *Nguyen* that illustrates their reduction to practice that embodiment of the claimed invention wherein the acid-releasing material is a lactide. There are, however, no similar showings for the other embodiments of said materials expressly delineated in the independent claims. MPEP 715.02 addresses situations such as these. "Even if applicant's 37 CFR 1.131

> affidavit is not fully commensurate with the rejected claim, the applicant can still overcome the rejection by showing that the differences between the claimed invention and the showing under 37 CFR 1.131 would have been obvious to one of ordinary skill in the art, in view of applicant's 37 CFR 1.131 evidence, prior to the effective date of the reference(s) or the activity. Such evidence is sufficient because applicant's possession of what is shown carries with it possession of variations and adaptations which would have been obvious, at the same time, to one of ordinary skill in the art."
>
> Applicant has made no such showing hence the 37 CFR 1.131 affidavit cannot be considered a foundation for withdrawal of the rejection at this time. Were Applicant to provide evidence that the other materials would have been viewed as obvious permutations in a similar contextual relationship, the Examiner shall revisit the issue of whether the affidavit is effectual as a means of overcoming the prior art rejection.

(Final Office Action at pages 3-4.) Applicants respectfully disagree with these rejections.

In order to overcome a § 102(e) rejection, a patent applicant must show that he or she was "in possession of" the full scope of the claimed invention prior to the effective date of the cited reference. *See* MANUAL OF PATENT EXAMINING PROCEDURE § 715.02 (2005). A declaration under 37 C.F.R. 1.131 is sufficient to show this where the declaration describes the claimed invention, or where the differences between the claimed invention and the embodiments described in the affidavit would have been obvious to a person of ordinary skill in the art. *See id.* Applicants' Declaration is sufficient to overcome these rejections since the embodiments described therein and their obvious variants clearly establish that Applicants were in possession of their invention as encompassing acid-releasing materials covered by their claims prior to the effective date of the Nguyen Application.

Applicants' independent claims each recite the use of an acid-releasing degradable material selected from the group consisting of lactides, poly(lactides), glycolides, poly(glycolides), substantially water-insoluble anhydrides, poly(anhydrides), derivatives thereof, and combinations thereof. Exhibit A to Applicants' Declaration shows that, prior to the effective date of the Nguyen Application, Applicants specifically acknowledged that their invention involved the use of materials that, when "placed in an aqueous media . . . will eventually hydrolyze to the parent α-hydroxy acid." (*See* Declaration at Exhibit A, page 1.) (A courtesy copy of the Declaration has been included with this filing for the Examiner's convenience.) Applicants specifically noted at that time that lactides and glycolides were examples of cyclic

double esters of carboxylic acids that hydrolyze to produce carboxylic acids, and thus Applicants were at least in possession of these specific examples of acid-releasing materials. *See id.* Moreover, substantially water-insoluble anhydrides are simply additional examples of compounds that also undergo hydrolysis to yield carboxylic acids, and thus, to a person of ordinary skill in the art, substantially water-insoluble anhydrides would be obvious variants of those embodiments described in Applicants' Declaration. *See* G. MARC LOUDON, ORGANIC CHEMISTRY 989 & 995-96 (3rd ed. 1995) (for example, see Equation 21.22). (A courtesy copy of the cited pages of this reference have been included with this filing for the Examiner's convenience.)

The same is true of the poly(lactides), poly(glycolides), and poly(anhydrides) recited in Applicants' claims. Similar to their monomeric counterparts, these compounds all hydrolyze to yield carboxylic acids, and thus would be obvious variants of monomeric lactides, glycolides, and anhydrides. Thus, the Declaration establishes that Applicants were in possession of the full scope of the invention recited in their claims prior to the effective date of the Nguyen Application.

Therefore, Applicants respectfully assert that the Nguyen Application should not be cited as a prior art reference against the present application under 35 U.S.C. § 102(e), and respectfully request withdrawal of these rejections with respect to claims 1, 2, 7-9, 14-16, 21, 22, 27, and 30.

IV. Rejections of Claims Under 35 U.S.C. § 103(a)

Claims 3, 4, 10, 11, 17, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Nguyen Application in view of U.S. Patent Nos. 5,813,466, 5,224,546, and/or 6,793,018, for the reasons cited in the previous office action(s). (*See* Final Office Action at page 3.) Applicants respectfully disagree with these rejections because the Nguyen Application is not available as prior art under 35 U.S.C. § 103(a) or § 102(e).

First, Applicants respectfully reiterate that the Nguyen Application is not available as prior art under § 103(a) in accordance with § 103(c). Section 103(c) provides that "[s]ubject matter developed by another person, which qualifies as prior art only under [§ 102(e)] shall not preclude patentability under [§ 103(a)] where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." 35 U.S.C. § 103(c). Because the Nguyen

Application was published after the filing date of the present application it can be available as a prior art reference only under § 102(e). Indeed, the Final Office Action has only cited this reference in § 102 rejections under § 102(e). The present application and the Nguyen Application were, at the time the invention of present application was made, both owned by Halliburton Energy Services, Inc. As the present application was filed on or after November 29, 1999, Applicants' statement of common ownership at the time the invention of the present application was made is sufficient to remove prior art from the purview of § 103(a) since that prior art could have been prior art only under § 102(e). *See* MANUAL OF PATENT EXAMINING PROCEDURE § 706.02(l)(2). Thus, the Nguyen Application is no longer available as prior art under § 103(a) in accordance with § 103(c).

Moreover, as discussed in Section III above, Applicants' Declaration Pursuant 37 C.F.R. § 1.131 establishes a reduction to practice of Applicants' invention prior to August 5, 2003, the effective date of the Nguyen Application, and thus the Nguyen Application is not available as prior art against Applicants' claims.

For these reasons, Applicants respectfully request the withdrawal of these rejections against claims 3, 4, 10, 11, 17, and 18.

V. No Waiver

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the cited references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art. The example distinctions discussed by Applicants are sufficient to overcome the obviousness rejections.

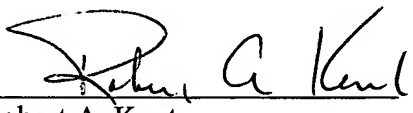
SUMMARY

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Because this response has been filed within two months of when the Final Office Action was issued, Applicants respectfully request that the Examiner issue an advisory action if the Examiner does not find the

claims to be allowable in light of the amendments and remarks made herein. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants believe that no additional fees are due in association with the filing of this response. However, should the Commissioner deem that any additional fees are due, including any fees for extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition Therefor, and direct that any additional fees be charged to the Deposit Account of Halliburton Energy Services, Inc., No. 08-0300.

Respectfully submitted,



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